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EXAMINER
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TODD, GREGORY G

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* WAI H. PAK, SANJEEV KUMAR,  
ANIL KUMAR ANNADATA, and YU JEN WU

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Appeal 2017-007004  
Application 13/555,516  
Technology Center 2400

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Before THU A. DANG, JUSTIN BUSCH, and MATTHEW J. McNEILL,  
*Administrative Patent Judges.*

BUSCH, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's  
Final Rejection of claims 1–43. We have jurisdiction under 35 U.S.C.  
§ 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

The claims relate generally receiving messages and responses thereto  
and converting the responses into different formats. *See Spec.* ¶¶ 9, 25–27.  
Claims 1, 11, and 21 are independent claims. Claim 1 is reproduced below:

1. A method comprising:  
receiving a message, wherein  
the message is in a native format,

the native format uses a first character set for displaying text,  
the message comprises a customer support request,  
the message is received by an application program server, and  
the message is received from a message client that is communicatively coupled to the application program server;  
receiving a response corresponding to the message,  
wherein  
the response is responsive, at least in part, to the message,  
the response is received by the application program server,  
the response is received from an application program client that is communicatively coupled to the application program server,  
the response is in a response format,  
the response format uses a second character set for displaying text, and  
the response format differs from the native format;  
converting, using one or more processors, the response from the response format to an independent format, wherein  
the independent format is independent of the first and second character sets;  
identifying a final response format, wherein  
the final response format is a format configured to facilitate a subsequent display of the response; and  
converting, using the one or more processors, the response from the independent format to the final response format.

#### REJECTIONS

Claims 1–43 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 2–5.

Claims 1–43 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Chesnais (US 2002/0087704 A1; July 4, 2002), Odinak

(US 2003/0177009 A1; Sept. 18, 2003), and Banerjee (US 2003/0033334 A1; Feb. 13, 2003). Final Act. 5–14.

## ANALYSIS

### REJECTION OF CLAIMS UNDER 35 U.S.C. § 101

The Examiner rejects the pending claims under 35 U.S.C. § 101 because the claims as a whole are directed to an abstract idea and do not contain “significantly more than the abstract idea” so as to transform the claimed abstract idea into a patent-eligible application. Final Act. 2–5; Ans. 2–5. Appellants argue the Examiner fails to meet the basic requirements for establishing a *prima facie* case of subject matter ineligibility under § 101. Br. 11–12. Appellants also contend the Examiner fails to establish that the claims are directed to an abstract idea and that the additional elements of the claims do not amount to significantly more than an abstract idea. *Id.* at 12–15.

### *Framework*

The Patent Act defines patent-eligible subject matter broadly: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. There is no dispute in this Appeal that the pending claims are directed to one of these categories.

In *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 70 (2012), and *Alice Corp. v. CLS Bank International*, 134 S.Ct. 2347, 2354 (2014), the Supreme Court explained that § 101 “contains an important implicit exception” for laws of nature, natural phenomena, and abstract ideas. *See Diamond v. Diehr*, 450 U.S. 175, 185 (1981). In *Mayo*

and *Alice*, the Court set forth a two-step analytical framework for evaluating patent-eligible subject matter: (1) “determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea; and, if so, (2) “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements” add enough to transform the “nature of the claim” into “significantly more” than a patent-ineligible concept. *Alice*, 134 S.Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79); see *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

Step one in the *Mayo/Alice* framework involves looking at the “focus” of the claims at issue and their “character as a whole.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). Step two involves the search for an “inventive concept.” *Alice*, 134 S.Ct. at 2355; *Elec. Power*, 830 F.3d at 1353. For an inventive concept, “more is required than ‘well-understood, routine, conventional activity already engaged in’” by the relevant community. *Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1047 (Fed. Cir. 2016) (quoting *Mayo*, 566 U.S. at 79–80).

#### *Prima Facie Case*

Appellants assert the Examiner failed to make a prima facie case of ineligibility because the Examiner’s “reasoning does not explain why the claims are unpatentable clearly or specifically.” Br. 12. We disagree.

The Examiner has a duty to give notice of a rejection with sufficient particularity to give Appellant a fair opportunity to respond to the rejection. See 35 U.S.C. § 132(a). Here, we find the Examiner’s rejection satisfies the initial burden of production by identifying that the claims include limitations similar to the identified abstract idea of a method of organizing human

activity or receiving data, and that the remainder of the claims do not include significantly more than the abstract idea because the generically-recited routine use of a computer, which is merely receiving data to facilitate the method of organizing human activity (i.e., translation), does not add meaningful limitations to the abstract idea. Final Act. 2–3; Ans. 2–3. The Examiner also found that claims courts previously held were directed to abstract ideas were similar to Appellants’ claims. Final Act. 3–4. Thus, the Examiner set forth the statutory basis for the rejection—namely 35 U.S.C. § 101, concluded that the claims are directed to a judicial exception to § 101—namely an abstract idea, adding too little to the abstract idea to render the claims patent eligible, and explained the rejection in sufficient detail to permit Appellants to respond meaningfully. *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011).

In fact, Appellants specifically argue against the Examiner’s findings and conclusions relating to what Appellants’ claims are directed to, whether that is an abstract idea, and whether the claims recite significantly more than the abstract idea itself. Br. 12–15. Accordingly, we find that the Examiner set forth a *prima facie* case of ineligibility.

*Step One of Alice Framework*

Turning to step one of the *Alice* framework, the Examiner finds the claims are directed to an analog of a translator translating a message from one person to another and the response back from the recipient of the message to the originator of the message, which is a method of organizing human activity and has “been used for centuries to facilitate communication between individuals who speak different languages.” Final Act. 3–4; Ans. 3–5. The Examiner identifies cases where similar claims were found to

be directed to abstract ideas. Final Act. 4 (citing *Novo Transforma Techs., LLC v. Sprint Spectrum L.P.*, No. 14-cv-00612, 2015 WL 5156526 (D. Del. Sept. 2, 2015), *aff'd*, 669 F. App'x 555 (Fed. Cir. 2016)); Ans. 4–5.

Appellants assert the method of organizing human activity to which the Examiner finds Appellants' claims are directed (i.e., translation, which is a form of data collection and manipulation of that data from one format to another) is not a method that is an abstract idea because the Examiner fails to explain “why the subject matter of the claims relates to interpersonal and intrapersonal activities, such as managing relationships or transactions between people, social activities, and human behavior; satisfying or avoiding a legal obligation; advertising, marketing, and sales activities or behaviors; and managing human mental activity.” Br. 13.

In *Novo*, the Specification of the claims at issue stated “that the claimed invention addresses the problem of ‘incompatibility between different communication services employing different media for communicating information.’” 2015 WL 5156526, at \*3 (quoting Specification of U.S. Pat. No. 5,826,034). The court then explained the problem the claims addressed was specific to computer networks or rooted in computer technology. *Id.* (distinguishing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014)). The court further stated:

Incompatible communication types have existed since before the emergence of computers and the Internet. Translators have been used for centuries to facilitate communication between individuals who speak different languages. The translator receives a message in one language, translates it into another, and delivers the translated message. Here, the claims require a computer system that receives a payload in one media form,

translates it into a different media form, and delivers the translated payload. This is no different than the function of a translator.

*Id.*; accord *Messaging Gateway Solutions, LLC v. Amdocs, Inc.*, No. 14-cv-732, 2015 WL 1744343, \*4 (D. Del. Apr. 15, 2015) (Finding a claim that received a short message service text message, converted it to an Internet Protocol message, and delivered the converted message was directed to the abstract idea of translation.).

Furthermore, as explained by the Examiner, the claims are directed to receiving messages and responses and converting messages between formats. Such a concept is similar to collecting and manipulating data, which the Federal Circuit has found to be an abstract idea. *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1142, 1150 (Fed. Cir. 2016) (finding claims reciting “[a] method for converting a hardware independent user description of a logic circuit . . . into logic circuit hardware components” were “drawn to the abstract idea of: translating a functional description of a logic circuit into a hardware component description of the logic circuit”); *Novo Transforma Techs. LLC v. Sprint Spectrum, L.P.*, 669 F. App’x 555 (Fed. Cir. 2016) (unpublished per curiam mem.) (affirming district court’s grant of summary judgement of invalidity of patent as being directed to patent-ineligible subject matter that was directed to nothing more than the abstract idea of translation of a data from one format to another); *Broadband iTV, Inc. v. Hawaiian Telcom, Inc.*, 669 F. App’x 555 (Fed. Cir. 2016) (unpublished per curiam mem.) (affirming district court’s grant of summary judgement of invalidity of patent as being directed to patent-ineligible subject matter that was directed to nothing more than the abstract idea of translation of a data from one format to another); *see also Elec.*



*Power*, 830 F.3d at 1353–54 (finding collecting, analyzing, and displaying information, regardless of particular content, is an abstract idea); *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Assoc.*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (finding collecting, recognizing, and storing information is an abstract idea).

For the above reasons, we are unpersuaded the Examiner erred in concluding the claims are directed to an abstract idea.

*Step Two of Alice Framework*

Next, we turn to step two of *Alice* to determine whether the limitations, when considered both “individually and ‘as an ordered combination’” contain an “inventive concept” sufficient to transform the claimed “abstract idea” into a patent-eligible application. *Alice*, 134 S.Ct. at 2355–58. The Examiner finds the claims merely recite using a generic computer system to assist in the translation and delivery of messages, and determines the recitation of generic computer programs and systems do not transform the abstract idea into patent-eligible subject matter. Final Act. 3–4; Ans. 3–4 (citing *Alice*, 134 S.Ct. at 2358).

Appellants argue the Examiner has failed to show the claims do not recite significantly more than the abstract idea itself because “they recite a computer-implemented solution to” the problem of providing international customer support, which needs to account “for different systems, languages, and formats of customers and agents.” Br. 14. Appellants further contend the claims provide a single user interface allowing customers and agents to communicate in different formats. *Id.* Appellants also assert the claims recite “various levels of conversions” and the invention “addresses the problems encountered when trying to provide customer support across

various systems, languages, and/or formats.” *Id.* at 14–15. Appellants argue the claims provide more than routine or conventional computer activity, require a device that is configured to manage and convert communications between formats and character sets, and are rooted in computer technology, rendering the claims patentable because they recite significantly more than the abstract idea of translation. *Id.* at 15 (citing *DDR Holdings*, 773 F.3d 1245). We are unpersuaded the Examiner erred in concluding the claims are directed to an abstract idea, and we address Appellants’ contentions below.

Appellants’ contention that the claims are rooted in computer technology and require a specially configured device performing unconventional computer activity is unpersuasive because the claims merely use generically recited computer elements to perform transmission and translation functions that are routine and not unique to the particular environment. Appellants provide no persuasive explanation regarding how the problem solved by the claims is tied to computers other than through the generic recitation of computers to perform the receiving and converting of messages, which amounts to merely application of computers to the abstract idea of exchanging and converting messages.

Appellants’ claims do not address a problem rooted in technology. These claims are not like those in *Enfish*, where the Federal Circuit found the claims eligible because they were focused on a specific software-based improvement to database techniques. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016). Nor are these claims like those found eligible when “the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” *DDR Holdings*, 773 F.3d at 1257. The claims in

*DDR* required an inventive device or technique for displaying information. *DDR*, 773 F.3d at 1257.

Unlike *DDR* and *Enfish*, receiving and converting messages is not a problem specifically arising in the realm of computers. Instead, the claims' character, as a whole, lies in longstanding conduct that exists apart from computers—i.e., receiving and converting messages and responses. *See Novo*, 2015 WL 5156526, at \*4. In Appellants' own words, the invention “enables a single interface to be used to prepare and present messages in a variety of different formats,” which addresses the identified problem that a “company must purchase different software products to handle each messaging system [and] agents must learn to use a different user interface for each messaging system,” degrading the efficiency of agents. Spec. ¶¶ 6, 8.

Notwithstanding the pending claims' recitation of a generic computer devices or programs, the claims are directed to using computers to receive and convert messages and responses, which is merely the application of computers to solve a conventional problem of incompatibility. Thus, the pending claims are not similar to patent-eligible claims that are directed to “an improvement in computers as tools,” but rather invoke computers merely as a tool aiding a process focused on an abstract idea. *Elec. Power*, 830 F.3d at 1354. Furthermore, the Federal Circuit has recognized that “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible. *See Alice*, 134 S.Ct. at 2359 (‘use of a computer to create electronic records, track multiple transactions, and issue simultaneous instructions’ is not an inventive

concept).” *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015), *cert. denied*, 136 S.Ct. 701 (2011).

Appellants’ argument that the claims require a single user interface for allowing customers and agents to exchange messages in different formats is similarly unpersuasive because it is not commensurate with the scope of the claims. The claims merely recited receiving and converting messages. The claims do not recite any user interface. Moreover, simply reciting a generic interface that facilitates the claimed abstract idea, without technological improvements likely would not provide the required “inventive concept” to render the subject matter patent eligible. *See Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240–43 (Fed. Cir. 2016).

For the above reasons, Appellants have not persuaded us of error in the rejection of the claims under 35 U.S.C. § 101.

#### REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

The Examiner rejects claims 1–43 under 35 U.S.C. § 103(a) as being obvious in view of Chesnais, Odinak, and Banerjee. Final Act. 5–14. Appellants identify relevant law and block quote portions of each cited reference and portions of the Examiner’s rejection, without explaining the significance of each quoted section. Br. 15–28. Regarding claims 1–33, 36, 37, and 39–43, Appellants contend the cited portions of the references “fail to teach or suggest the use of four distinct formats (e.g., a native format, a response format, an independent format, and a final response format) and at least two distinct character sets (e.g., a first and second character sets) for providing” the functionality of “receiving a single message, and providing a response thereto” in “a single environment (e.g., an environment that comprises an application program server, a message client, and an

application program client being communicatively coupled to one another).”

Br. 28. With respect to claims 34, 35, and 38, Appellants further argue the cited combination of references does not teach or suggest, respectively: using three distinct character sets or a final response format indicating a third character set; a fourth character set, a response format indicating a third character set, or converting the response using the fourth character set; and a native format of a message and a response format of a response comprising distinct language types. *Id.* at 28–30. Appellants provide no further explanation of their arguments, and Appellants did not file a Reply Brief.

Appellants’ arguments, however, do not persuasively address the Examiner’s findings. Initially, as the Examiner notes, certain aspects of Appellants’ arguments are not commensurate with the scope of the claims. Ans. 7. In particular, to the extent Appellants contention that claim 1 requires “four distinct formats” is intended to assert that each of the four recited formats must be different, we disagree. Rather, claim 1 recites a message in a native format using a first character set, a response in a response format, which is different than the native format, using a second character set, an independent format that is “independent of” the first and second character sets (but has no recited relationship to the native or response format) and a response format, which is not necessarily different than any of the previously recited formats. Similarly, the claims do not require four distinct character sets. None of the claims recite that the character sets are different from any of the other character sets. Thus, although the claims encompass using four different formats and character sets, they do not require it.

Even to the extent the particular details of the type of information are given patentable weight, the Examiner provides specific mappings and a rationale for combining the identified teachings.<sup>1</sup> Final Act. 5–8. In particular, the Examiner finds Chesnais teaches or suggests an application program server receives messages in a native format from a message client, receiving a response to the message in a format different than the native format, converting the response to an independent format (e.g., Uniform Media Format), and converting the response from the independent format to a final response format according to a subscriber’s selected format. Final Act. 5–6 (citing Chesnais ¶¶ 38, 41–44, 239, 240); Ans. 5–7. The Examiner relies on Odinak as teaching or suggesting that the message is a customer support request and the response is received from an application program client. Final Act. 6–7 (citing Odinak ¶¶ 42, 50, 53, 60, 61, 66, 67, 76, 88, Fig. 7). The Examiner finds Banerjee teaches using different character sets in different messages and converting character sets to Unicode and back to character sets that are recognizable by a client according to language and formatting used by that client. Final Act. 7–8 (citing Banerjee ¶¶ 10, 38–45), 11–12; Ans. 7–8. Finally, the Examiner provides a rationale for combining the identified teachings. Final Act. 7–8, 12–13.

Given the Examiner’s findings and Appellants’ lack of specific or particular arguments identifying allegedly deficient findings or conclusions,

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<sup>1</sup> See *Ex parte Nehls*, 88 USPQ2d 1883, 1889 (BPAI 2008) (precedential) (“[T]he nature of the information being manipulated does not lend patentability to an otherwise unpatentable computer-implemented product or process.”); *In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (holding informational content of non-functional descriptive material is not entitled to patentable weight).

we are not persuaded the Examiner erred. Accordingly, on this record and for the reasons discussed above, we sustain the Examiner's rejections of claims 1–43 under 35 U.S.C. § 103(a).

SUMMARY

We sustain the Examiner's rejections of claims 1–43 under 35 U.S.C. § 101 and of claims 1–43 under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner's rejection of claims 1–43.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED